

REMARKS

Summary of the Office Action

Claims 1, 2, 4-7, 9-21, 40, and 45-53 are pending in the above-identified patent application.

Claims 12 and 13 were indicated to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Claims 1, 2, 4-7, 9-11, 14-21, 40, and 45-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,241,451 to Walburn et al. ("Walburn") in view of U.S. Patent No. 5,269,213 to Coneski et al. ("Coneski").

Summary of Applicant's Reply

Applicant appreciates the Examiner's indication of allowable subject matter in claims 12 and 13, and respectfully reserves the right to rewrite the claims in independent form to include all the limitations of the base claim and any intervening claims.

A Supplemental Information Disclosure Statement is being filed concurrently herewith. A Petition for a one-month extension of time is also being filed concurrently herewith.

The Examiner's claim rejections under section 103 are respectfully traversed.

The Section 103 Rejection

Applicant's claim 1 is directed to a connecting means for releasably fixing a first element and a second element, and applicant's claim 14 is directed to a method for releasably fixing a first element and a second element via a connecting means. The connecting means of claims 1 and 14 includes a locking means that is movable between a locked position and an unlocked

position by a remote activation means. As recited in claims 1 and 14, there is “no physical contact” between the remote activation means and the connecting means.

The Examiner has rejected claims 1 and 14 as being unpatentable over Walburn in view of Coneski. In particular, the Examiner contends that Walburn discloses connecting means including locking means moveable by remote activation means between a locked position and an unlocked position. Office Action, p. 2. The Examiner correctly submits that claims 1 and 14 have novelty over Walburn, recognizing that “Walburn et al. does not disclose a lack of physical contact between the connecting means and the remote activation means.” Office Action, p. 2. However, the Examiner asserts that Coneski discloses this feature of applicant’s claims 1 and 14, and that it would have been obvious to combine Walburn with Coneski. Applicant respectfully disagrees, and submits that (1) the combination of Walburn with Coneski fails to teach or suggest all the features of applicant’s claims 1 and 14, and (2) the Examiner’s proffered motivation to combine Walburn with Coneski is insufficient.

The Combination of Walburn with Coneski Fails to Teach or Suggest All the Features of Applicant’s Claims 1 and 14

The Examiner contends that “Coneski et al. teaches use of an actuation means (20,25) not contacting the connection means (60) to reduce wear on the actuation means.” Office Action, p. 2. Applicant respectfully disagrees, and submits that plunger 25 of Coneski makes *physical contact* with drive rod 60.

Notably, Coneski describes the interaction between plunger 25 and drive rod 60 as follows:

In order to avoid and overcome wearing out of the plunger 25 due to its impacting of the drive rod 60, a material of sufficient hardness can be employed to form a replaceable insert 105 which is disposed in the plunger 25 at its *point of impact* with the drive rod 60.

Coneski, col. 3, ll. 35-39, emphasis added. As described, plunger 25 of Coneski uses a replaceable insert 105 to avoid prematurely wearing out the plunger. This insert 105 is of “equal or greater hardness” than the material of drive rod 60. Coneski, col. 3, ll. 45-46. Although insert 105 may be initially separate from plunger 25, it is “insert[ed]” into place at the face of the plunger, thereby forming an integral whole. See FIG. 1 of Coneski, a portion of which is reproduced below for reference.

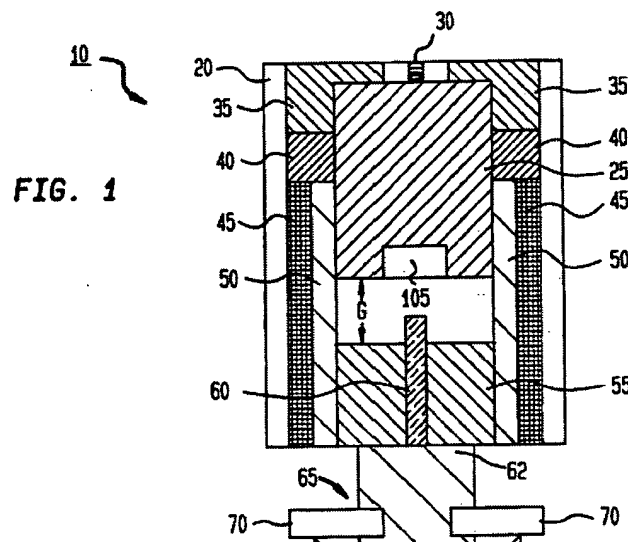


FIG. 1 of Coneski

Thus, because the plunger is *in physical contact* with drive rod 60, Coneski does not teach or suggest a lack of physical contact between a connecting means and a remote activation means as set forth in claims 1 and 14.

In addition to failing to teach or suggest a lack of *physical contact*, Coneski also fails to teach or suggest a “connection means,” as the Examiner asserts in the Office Action. Office Action, p. 2. Plunger 25 of Coneski interacts with drive rod 60. This drive rod is not a connecting means as claimed by applicant, but rather is used to drive a punch: “the compressed drive rod 60 rebounds and transfers the kinetic energy to the punch 65, thus driving the punch 65 toward the sheet 15.” Coneski, col. 3, ll. 48-50.

Thus, contrary to the Examiner's contention, Coneski fails to teach or suggest the use of a remote activation means in which there is no physical contact between the remote activation means and a connecting means, as recited in claims 1 and 14. Furthermore, as the Examiner correctly submits, Walburn also fails to teach or suggest this feature of applicant's claims. Thus, at least due to this deficiency, the combination of Walburn and Coneski fails to teach or suggest all the features of claims 1 and 14, and the rejection of the claims under section 103 should be withdrawn.

**The Examiner's Proffered Motivation to Combine
Walburn with Coneski Is Insufficient**

As provided above, the combination of Walburn and Coneski fails to teach or suggest all the features of applicant's claims 1 and 14. Furthermore, even if the combination were sufficient, which it is not, applicant submits that the Examiner's proffered motivation to combine Walburn with Coneski is insufficient.

In particular, the Examiner asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to arrange for the connection means to not be effected by physical contact with the actuation means, as taught by Coneski et al. to avoid associate damage thereby extending the useful life of the actuator." Office Action, pp. 2-3. However, while there is a great potential for damage existing in Coneski, due to the substantial, repetitive downward forces applied by plunger 25 on drive rod 60, such a risk does not exist in Walburn.

Walburn involves the insertion and subsequent removal of a plunger 35 into a connector housing 10. *See* FIGS. 12 and 13 of Walburn; col. 5, ll. 28-45. The insertion and removal of the plunger does not require substantial, repetitive downward forces as required in the device of Coneski. Thus, one of ordinary skill in the art would not have been motivated to combine

Walburn with Coneski to “avoid . . . damage” to plunger 35 as asserted by the Examiner. The Examiner has therefore failed to provide an adequate motivation to combine Walburn with Coneski, and the rejection of claims 1 and 14 under section 103 should be withdrawn.

Summary

Accordingly, for at least the reasons set forth above, applicant’s claims 1 and 14 are patentably distinct over Walburn in view of Coneski, and the rejection of the claims should be withdrawn. In addition, dependent claims 2, 4-7, 9-11, 15-21, 40, and 45-53 are allowable for at least the reasons that applicant’s independent claims 1 and 14 are allowable. Accordingly, the Examiner’s rejections of these claims under section 103 are moot and should also be withdrawn.

Conclusion

Applicant respectfully submits that, as described above, the cited references do not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited references show any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combinations of limitations recited in the claims includes additional limitations not shown or suggested by the cited references. Therefore, for these reasons as well, applicant respectfully requests withdrawal of the rejection.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly

not present in the cited references, as discussed above. However, applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely applicant's best attempt at providing one or more definitions of what applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that applicant is seeking for this application. Therefore, no estoppel should be presumed, and applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

Authorization

The Director is hereby authorized to charge any additional fees which may be required for this Reply, or credit any overpayment, to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Director is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,
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